APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,581	09/04/2001	Erika C. Dabney	D/A1189	2510

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EXAMINER
QIN, YIXING

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/944,581	DABNEY ET AL.
	Examiner	Art Unit	
	Yixing Qin	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *18 January 2007*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,2,4 and 6-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,2,4 and 6-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *04 September 2001* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to applicant's amendment received 1/18/07, all requested changes have been entered.

Response to Arguments

Applicant's arguments filed 11/18/07 have been fully considered but they are not persuasive. The argument is that the incorporation of claim 5, which more precisely defines the invention, into claim 1 renders the claims allowable over the prior art combination of Shima and Fein because the Fein reference does not show how one can generate novel error messages not associated with a determined error. The Examiner points to column 10, lines 35-57, which describes Fig. 4 in more detail. Lines 39-50, especially, discloses that the Fein invention can be extended to other types of events and conditions, and can contain messages that are simply reminders. This gives the ability to generate novel messages according to some event or condition. Print GUIs have been known to have the ability to incorporate pop up windows – e.g. the "?" box on the top right corner of conventional print GUIs can be clicked and then another button on the GUI can be clicked so that a pop up help box appears describing the functions of that button. The present invention pops up the window in response to changing the number of copies to a plural number (which is basically setting a condition on the print GUI). Thus, while the message claimed is not explicitly disclosed by the Fein reference, it gives enough information to suggest that one of ordinary skill can come up with custom messages in response to changing a condition. The rejection is maintained.

Allowable Subject Matter

Claims 16-21 allowed. Claim 9 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: The prior art of record does not disclose a print driver UI that reports to a software application that one copy of a job will be printed, while still printing multiple copies of the job, in combination with the other aspects of the claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

I.   Claims 1, 4-8, 10-12 and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Word in view of Shima (U.S. Patent No. 6,676,309) and further in

view of Fein et al (U.S. Patent No. 5,565,608).

         Regarding claim 1, the Word reference discloses a print driver user interface

method for printing a document, comprising at said print driver:

         receiving a number corresponding to a plural number of copies of the document

to be printed from a software application; (Fig. A that 5 copies of a document are to be

printed. Fig. C shows the 5 copies have been received. The Examiner interprets Fig. B

as the print driver UI and one can see it is accessed by hitting the properties button in

Fig. A. Figs. C, D and E are various screens showing how a user can choose copies in

the advanced options of the Layout tab as shown in Fig. B. Figs. C, D and E are

therefore part of the print driver UI, Fig. B.)

         receiving at least one command relating to an operation to be performed on each

of the plural number of copies of the document to be printed; (One can see in Figs. C, D

and E various commands under the Document Options and Printer Features headings.)

         displaying a first feature to a user in response to receiving a plural number of

copies of the document to be printed; (Please note the difference between Figs. D and

E. Notice that when the number of copies is set to 1, the collated checkbox in Fig. E is

disabled and that when the number of copies is 5 (i.e. more than 1), the collated

checkbox in Fig. D is enabled. This shows that the print driver UI of Word can perform

a function in response to receiving a plural number of copies of a document to be printed. This can read upon displaying a first feature.)

The Word reference does not explicitly disclose "offering the user a choice to select to transfer control of printing the copies from the software application to the print the print driver; and transferring control of printing the number of copies from the software application to the print driver."

However, the applicant's specification notes in Fig. 3 and on page 5, lines 3-5 that when the user clicks ok on a print dialog box, the control is transferred to the print driver from the application. The secondary reference, Shima, teaches this idea in column 7, lines 7-12. Note also in column 6, lines 35-42 for various printing settings that are sent when the ok button is selected. This indicates that

The Word reference and Shima are combinable because both are in the art of controlling print jobs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Word and Shima, so the control of the printing to can be transferred to the print driver.

The motivation would be to ensure proper printing, as this is a necessary step in obtaining a printed document.

Therefore, it would have been obvious to combine The Word reference and Shima to obtain the invention as specified.

Regarding claim 2, the Word reference discloses the method of claim 1,

further comprising offering the user the option to reselect a number of copies of the

document to be printed. (Fig. E of Word there is a box for the selection of copies to be

printed. The user can reselect the number of copies as many time as he/she wishes.)

Regarding claim 4, the Word reference discloses the method of claim 1

wherein said permitting the user to select to transfer control includes permitting the user

to select that there is a problem printing multiple copies. (as discussed in the arguments

above, the "problem printing multiple copies" has no concrete meaning at this point and

is interpreted to be simply another checkbox or button. The Word reference shows

various checkboxes and buttons.)

Regarding claim 5, the Word reference discloses a print driver UI.

It does not explicitly disclose "the method of claim 1 wherein the first

feature informs the user that the software application may have a problem printing

multiple copies."

However, the secondary reference, Fein discloses in Figs. 2 and 3 common

printer error messages. In Fig. 4, Fein shows that there are custom messages that one

can create based on situational conditions. One of ordinary skill knows that printing

plural copies is common in the art of printing and would be obvious to have

implemented a custom message in case there is an error printing multiple copies.

The Word reference and Fein are combinable because both are in the art of print dialogs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a custom message in the Word reference.

The motivation would have been to alert users to potential errors. Therefore, it would have been obvious to combine The Word reference and Fein to obtain the invention as specified.

Regarding claims 6 and 11, the Word reference discloses the method of claim 1 further comprising offering the user to select the operation to be performed. (options in Figs. B-E of Word can be selected by a user.)

Regarding claims 7 and 12, the Word reference discloses the method of claim 1 wherein the operation to be performed was received from the software application. Fig. F of Word that under zoom options, a pages per sheet and scale to letter size can be picked using the software application and gets reflected in the print driver UI in the Effects Tab.)

Regarding claim 8, the Word and Shima references disclose various features in their print UI.

It does not explicitly disclose "further comprising displaying a second feature to the user that explains the purpose and function of transferring control of printing the copies from the software application to the print driver."

However, the displaying of dialog/message boxes to help users or for explanation

is well known (i.e. see Miller – U.S. Patent No. 5,442,687 and Palmer et al – U.S. Patent

No. 5,825,355). One can see the help button on the interface of Word (i.e. the question

mark on the top right hand of the window). One skilled in the art would also know that

many programs include a help menu for the explanation of how to perform various

tasks. The Examiner asserts that the displaying of an explanation of a tasked

performed is an obvious engineering design choice (i.e. similar to if one wanted to have

a message box popping up displaying what the number of copies box is for or what the

print quality box is for in a print dialog).

Therefore, it would be obvious for one of ordinary skill to have combined these

teachings to create an invention that includes a feature that explains a particular

function.

The motivation would be to enable a user to know important information about a

particular function in the print driver UI.

Regarding claim 10, the Word reference discloses a print driver UI method for

printing copies of a document, comprising at the print driver:

receiving a plural number corresponding to the number of copies to be printed

from a software application; (Fig. A that 5 copies of a document are to be printed. Fig.

C shows the 5 copies have been received. The Examiner interprets Fig. B as the print

driver UI and one can see it is accessed by hitting the properties button in Fig. A. Figs.

C, D and E are various screens showing how a user can choose copies in the advanced

options of the Layout tab as shown in Fig. B. Figs. C, D and E are therefore part of the

print driver UI, Fig. B)

receiving at least one command relating to an operation to be performed

on each of the plural number of copies to be printed; (Figs. C, D and E various

commands under the Document Options and Printer Features headings.) and

displaying a feature to a user informing the user that the software

application may have a problem printing multiple copies. (This limitation have been

addressed in claim 5 above)

Regarding claim 15, the Word and Shima references discloses dialog boxes.

It does not explicitly disclose "the method of claim 10 wherein the feature

also instructs the user on how to access the print driver UI."

However, none of the references explicitly teach the instructing of a user how to

access the print driver UI. However, one of ordinary skill knows that using a help menu

as discussed above is a conventional way in which a user can obtain information

regarding how to perform various tasks. It would be an obvious design choice to simply

combine pop up help boxes relating to performing a task when a user is choosing

options for that task with the particular print driver UI features as disclosed by Word,

Shima.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to have a message for helping a user accomplish a task.

The motivation would be to enable a user to receive pertinent information regarding printing using a print driver UI.

Therefore, it would have been obvious to combine The Word reference and Shima to obtain the invention as specified.

II.   Claims 13 and 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Word in view of Shima (U.S. Patent No. 6,676,309) in view of Fein et al (U.S. Patent No. 5,565,608) and further in view of Official Notice.

Regarding claims 13 and 14, The Word, Shima and Fein reference software UIs.

It does not explicitly disclose duplexing or stapling functions.

However, the Examiner takes Official Notice since duplexing and stapling are common in the printing art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included stapling and duplexing functions.

The motivation would have been to enable a user to customized the outputted paper.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
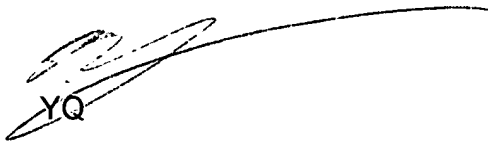
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yixing Qin whose telephone number is (571)272-7381.

The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TWYLER LAMB
SUPERVISORY PATENT EXAMINER